

REMARKS

State of the Claims

Claims 1-18 are pending. Claims 2, 4, 7 13 and 14 have been canceled without prejudice. Claim 18 has been amended to correct its dependency. Claims 1, 3, 6 and 8-12 and 15-18 remain. No new matter has been added.

35 U.S.C. § 112 Rejection

Claims 8-18 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. Claims 13 and 14 have been canceled without prejudice.

The Examiner states that the term “reduced” in Claims 13 and 15 is a relative term and therefore renders the claims indefinite. The Examiner further states that the term ‘reduced’ “is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.”

Applicants respectfully disagree with the Examiner’s assertions. First, Applicants point out that the claims alone do not have to define the term “reduced”. Rather, the specification can provide the proper basis for definition of any term used in the claim. Applicants assert that the specification does in fact provide the proper definition and understanding of the term “reduced” as it relates both to asparagine-reduction and acrylamide-reduction.¹

In addition, common usage of a term can provide definition for claim terms. For example, the term “reduced”, in common usage, is defined as “to lessen in extent, amount, number, degree or price.” The American Heritage Dictionary, 2nd Ed., Houghton Mifflin Company, Boston (1991). Such definition bolsters Applicants’ use of the term in their specification since Applicants teach the reduction of the amount of acrylamide in food material in comparison to food material not treated for such acrylamide reduction.

Whether one skilled in the art looks to the specification or to common usage, it would be apparent to one skilled in the art that the term “reduced,” as used in the presently rejected claims, means that the level of asparagine/acrylamide is less in treated food material, i.e., food material not exposed to asparagine-reducing enzymes. Thus, the term “reduced” means that the food material has been treated with an enzyme such that the level of asparagine/acrylamide is less than what it would be in untreated food material.

¹ Applicants’ Specification, page 3, lines 1-4: “Accordingly, Applicants have further discovered that acrylamide formation in heated foods can be *reduced* by decreasing the amount of reducing sugar or converting the reducing

Applicants respectfully assert that one skilled in the art would understand that the use of the term "reduced" in the present claims describes the level of asparagine or acrylamide in treated food material as compared to the level present in untreated food material. Therefore, it is respectfully asserted that the term "reduced" in the presently rejected claims does indeed provide a standard for ascertaining the meaning, such that one skilled in the art would be reasonably apprised of the scope of the claimed invention.

As such, Applicants respectfully request reconsideration and allowance of Claims 8-12 and 15-18 over the Examiner's 35 U.S.C. § 112, second paragraph, rejection.

Claims 14 and 16 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. Claim 14 has been canceled without prejudice. Claim 16 remains.

The Examiner states that the term "low" used herein is a relative term which renders the claims indefinite. The Examiner states that the term "low" is not defined by the claims, that the specification does not provide a standard for ascertaining the requisite degree, and that one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Lastly, the Examiner states that there is no standard or original amount of acrylamide provided in the specification such that one skilled in the art (or a consumer of the claimed article) would be apprised of what constituted a "low" amount of acrylamide within the article.

Applicants respectfully disagree with the Examiner. First, Applicants point out that Claim 16 is article of commerce claims and as such claim the communication of a "low" level of acrylamide in the food material. Such a communication is amply supported by the specification.²

In Claim 16, the message informs the consumer that the food material are low in acrylamide. Applicants assert that one of skill in the art would, by the claims themselves and from Applicants' specification, understand that the invention is an article of commerce that has as part of its packaging or advertising a message communicating the "low"-ness of acrylamide and the reduction thereof. Applicants further assert that a consumer reading this message would understand what this "low"-ness is intended to convey without, as the Examiner puts it, providing "a standard for ascertaining the requisite degree" of the "low"-ness of the acrylamide.

Furthermore, Applicants respectfully point out that the term "low" as used in claim 16 is simply a word on a label, and thus, there is no definiteness issue surrounding its use in this context. A label

sugar in the food to another substance before cooking. When such foods containing reduced levels of reducing sugar are heated, the amount of acrylamide formed is reduced." [Emphasis added.]

² *Id.* at page 16, lines 10-35.

either displays the term “low,” or a similar term, or it doesn’t. Therefore, because the presently rejected claim relates only to the labeling of the product, rather than the potato products, it is irrelevant what the term “low” actually means in these claims. (It will be left to the appropriate regulatory body to determine whether the use of the term “low” on a label, as claimed herein, is proper).

Thus, Applicants respectfully assert that the Examiner’s rejection of Claim 16 should be obviated and allowed to issue over the Examiner’s 35 U.S.C. § 112, second paragraph, rejection.

In Claim 18, the Examiner states that it is indefinite in that it modifies Claim 17 which claims the same thing that Claim 18 claims; namely, a food product that is a food ingredient.

Applicants have amended Claim 18 so that it now depends upon independent Claim 15. Applicants therefore assert that Claim 18 is no longer indefinite and is properly amended. No new matter has been added. Applicants request reconsideration and allowance of Claim 18 over the Examiner’s 35 U.S.C. § 112, second paragraph, rejection.

35 U.S.C. § 102 Rejection

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Gerrish, et al. (U.S. Patent No. 5,620,727—hereinafter Gerrish ‘727).

Claim 1 has been amended to include the subject matter of now-canceled Claims 2 and 4. Gerrish ‘727 does not teach the addition of a reducing-sugar enzyme to food material. Thus, Applicants assert respectfully assert that the Examiner’s 35 U.S.C. § 102(b) rejection should be rescinded and Claim 1 allowed to issue.

Furthermore, by amending Claim 1 to include the subject matter of now-canceled Claims 2 and 4, Applicants are expressly NOT surrendering the subject matter of Claim 1 or Claim 2 as originally filed and also expressly reserve the right to later file original Claim 1 and/or Claim 2 in this or a later filed case (e.g., a divisional).

Claims 1-3, 5-6 and 8-12 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Soeda, et al. (U.S. Patent No. 6,383,533). Claim 2 has been canceled. Claim 1 has been amended and includes the subject matter of now-canceled Claim 4. Therefore, Claim 1, in its amended form, overcomes the Examiner’s rejection. Also, Claim 5 has been amended to include the subject matter of now-canceled Claim 7. Therefore Claim 5, in its amended form, overcomes the Examiner’s rejection.

By amending Claims 1 and 5 to include the subject matter of now-canceled Claims 4 and 7, respectively, Applicants are expressly NOT surrendering the subject matter of either Claim 1 or Claim 2

as originally filed and also expressly reserve the right to later file original Claims 1, 2, 4, 5 and/or 7 in this or a later filed case (e.g., a divisional).

Claims 1-3, 5-6 and 8-12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sato, et al. (EP 0 468 731). Claim 2 has been canceled. Claim 1 has been amended and includes the subject matter of now-canceled Claim 4. Therefore, Claim 1, in its amended form, overcomes the Examiner's rejection. Also, Claim 5 has been amended to include the subject matter of now-canceled Claim 7. Therefore Claim 5, in its amended form, overcomes the Examiner's rejection.

By amending Claims 1 and 5 to include the subject matter of now-canceled Claims 4 and 7, respectively, Applicants are expressly NOT surrendering the subject matter of either Claim 1 or Claim 2 as originally filed and also expressly reserve the right to later file original Claims 1, 2, 4, 5 and/or 7 in this or a later filed case (e.g., a divisional).

35 U.S.C. § 103 Rejection

Claims 13-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over any of the following: Soeda '533 or Sato '731. Claims 13 and 14 have been canceled without prejudice. Claims 15-18 remain.

The Examiner states that it would have been obvious to one of ordinary skill in the art to have packaged and appropriately labeled the food products produced by Soeda '533 or Sato '731. Such packaging techniques, notes the Examiner, were well known in the art. The Examiner further states that Claims 15-18 do not refer to or require a heated or cooked product, and thus do not necessitate a "reduced amount of acrylamide" formation.

The Examiner bears the burden of factually supporting any prima facie conclusion of obviousness. In determining the differences between the cited art and the claims, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. See Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530 (Fe. Cir. 1983). Distilling the invention down to the "gist" or "thrust" of an invention disregards the requirement of analyzing the subject matter "as a whole." See W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983). Inventors of unobvious compositions, such as those of the present invention, enjoy a *presumption* of non-obviousness, which must then be overcome by the Examiner establishing a case of prima facie obviousness by the appropriate standard. If the Examiner does not prove a prima facie case of unpatentability, then without more, the Applicant is entitled to grant of the patent. See In re Oetiker, 977 F.2d 1443.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all of the claim limitations.³

Applicants respectfully disagree with the Examiner's assertions. Applicants' respectfully assert that the Examiner is using the wrong test for obviousness. The test is whether the reference itself, herein Soeda '533 or Sato '731, or knowledge generally available to one of skill in the art teaches or suggests Applicants' invention. Applicants assert that neither condition has been met.

First, nothing in Soeda '533 or Sato '731 teaches or suggests an article of commerce that communicates the reduction or lowness of 1) acrylamide (Claims 13 and 14—now canceled) or 2) reducing sugars (Claims 15-18) in Applicants' food material. In fact, neither Soeda '533 or Sato '731 suggest or teach the lowness or reduction of acrylamide or reducing sugars in food material.

Second, Applicants assert that one of skill in the art would not have been led to produce an article of commerce that communicates the reduction of either acrylamide or reducing sugars in food. Heretofore, the ability to reduce acrylamide or reducing sugars in edible structures producing asparagine has never been accomplished until Applicants accomplished this reduction. Thus, there was no knowledge generally held available to one of skill in the art that such a claim, i.e., the reduction or lowness of acrylamide or reducing sugars in food, was possible or even desired. Applicants point out that they claim an article of commerce having a message informing a consumer that the product has a reduced level of reducing sugars. Applicants are not claiming a generic message or merely words on a package which is within the knowledge of one of ordinary skill in the art. Rather, Applicants' message is specific to a heretofore unobtainable function by any one of skill in the art save Applicants. Such a message is therefore not within the knowledge of one of ordinary skill in the art.

Thus, Applicants respectfully request reconsideration and allowance of Claims 15-18 over the Examiner's 35 U.S.C. § 103(a) rejection in view of Soeda '533 or Sato '731.

Double Patenting - Non-Statutory

Claims 13-14 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of co-pending Application No. 10/606,260.

Applicants respectfully traverse these rejections. Applicants submit that the Examiner has failed to provide sufficient basis for asserting that the cited claims of U.S. Patent Application No. 10/606,260

³ In re Vaeck, 947 F. 2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

teach or suggest the claims of the present application which are directed to reducing asparagines or acrylamide in food. Accordingly, it is respectfully requested that the obviousness-type double patenting rejections be withdrawn.

Claims 13-14 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of co-pending Application No. 10/603,279. Claim 6 has been canceled without prejudice. Claims 1-5 and 7-44 remain.

Applicants respectfully traverse these rejections. Applicants submit that the Examiner has failed to provide sufficient basis for asserting that the cited claims of U.S. Patent Application No. 10/603,279 teach or suggest the claims of the present application which are directed to reducing asparagine or acrylamide in food. Accordingly, it is respectfully requested that the obviousness-type double patenting rejections be withdrawn.

Claims 1-12 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 11-44 and 47-50 of co-pending Application No. 10/606,137.

Applicants respectfully traverse these rejections. Applicants submit that the Examiner has failed to provide sufficient basis for asserting that the cited claims of U.S. Patent Application No. 10/606,137 teach or suggest the claims of the present application which are directed to reducing asparagines or acrylamide in food. Accordingly, it is respectfully requested that the obviousness-type double patenting rejections be withdrawn.

Claims 13-14 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-57 of co-pending Application No. 10/603,973.

Applicants respectfully traverse these rejections. Applicants submit that the Examiner has failed to provide sufficient basis for asserting that the cited claims of U.S. Patent Application No. 10/603,973 teach or suggest the claims of the present application which are directed to reducing asparagines or acrylamide in food. Accordingly, it is respectfully requested that the obviousness-type double patenting rejections be withdrawn.

Claims 13-14 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-18 of co-pending Application No. 10/603,278.

Applicants respectfully traverse these rejections. Applicants submit that the Examiner has failed to provide sufficient basis for asserting that the cited claims of U.S. Patent Application No. 10/603,278 teach or suggest the claims of the present application which are directed to reducing asparagines or

acrylamide in food. Accordingly, it is respectfully requested that the obviousness-type double patenting rejections be withdrawn.

Double Patenting - Statutory

Claims 13-14 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of Claims 45-46 of co-pending Patent Application No. 10/606,137. Claims 13-14 are, as asserted by the Examiner, have questionable priority under 35 U.S.C. § 102(g) and "possibly" 35 U.S.C. § 102(f).

Applicants have canceled Claims 13 and 14 herein without prejudice. The Examiner's rejections are all therefore obviated.

SUMMARY

The rejections in the Office Action have been discussed and, Applicants believe, the proper discussions and/or amendments have been set forth to address the rejection.

In light of both the amendments and the discussions contained herein, Applicants respectfully request reconsideration of the rejection and its withdrawal.

Issuance of a Notice of Allowance at an early date is earnestly solicited.

Respectfully submitted,

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